

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Offic**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/961,956 10/31/97 ROYO

J B-3379-61628

IM61/0426

EXAMINER

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PASTERCZYK, J

ART UNIT

PAPER NUMBER

1755

DATE MAILED:

04/26/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

<b>Office Action Summary</b>	Application No. <b>08/961,956</b>	Applicant(s) <b>Royo et al.</b>
	Examiner <b>J. Pasterczyk</b>	Group Art Unit <b>1755</b>



Responsive to communication(s) filed on Mar 1, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) 15-18 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-14 / 8 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Applicant's election with traverse of claims 1-14 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that it would be quite expensive for applicant to prosecute and maintain any issued patents which might result from the present application. This is not found persuasive because applicants have not set forth a proper reason as to why the restriction is improper, and why the inventions, as grouped, are not distinct.

The requirement is still deemed proper and is therefore made FINAL.

2. A further restriction requirement has been deemed necessary and is found below.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a compound useful as a catalyst, classified in class 556, subclass 12 for the transition metal compounds, class 534, subclass 11 for the actinide compounds, class 534, subclass 15 for the lanthanide or group 3 compounds.
- II. Claims 8-11, drawn to a supported catalyst component and method of making it, classified in class 502, subclass 152.
- III. Claims 12-14, drawn to a polymerization catalyst comprising a metal compound and cocatalyst, classified in class 502, subclass 102 for the cocatalyst being an aluminum compound, class 502, subclass 152 for the cocatalyst being a boron compound.
- VI. Claims 15-18, drawn to an olefin polymerization process, classified in class 526, subclass 127.

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4. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a material for the deposition of the metal by a CVD process. See MPEP § 806.05(d).

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, the former to act as a material for the deposition of a metal by a CVD process, the latter to act to polymerize olefins.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, the former to act as a material for the deposition of a metal by a CVD process, the latter to act to polymerize olefins.

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a pigment for UV-visible light filters. See MPEP § 806.05(d).

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Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, the former to act as a pigment for UV-visible light filters, the latter to act to polymerize olefins.

Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process as claimed can be practiced with another materially different product such as a Ziegler-Natta catalyst or a chromium oxide catalyst.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of the claimed invention: claims 1-7, drawn to group 3, 4, 10, lanthanide, or actinide compounds.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2 and 4 are generic. Claims 1, 2 and 4 are drawn to the entire group of metals. However, groups 3 and the lanthanides, groups 4 and 10, and the

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actinides, are all separately classified as noted above. If this group of claims 1-7 is selected for prosecution, election of one of the groups of metals as a separate specie for prosecution should also be done. Claims 3 and 5-7 are drawn only to the group 4 metals.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Claims 12-14 are generic to a plurality of disclosed patentably distinct species comprising a supported lanthanide or actinide catalyst with either a boron or aluminum cocatalyst, and a supported transition metal catalyst with either a boron or aluminum cocatalyst. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is

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traversed. The lanthanide or actinide metal plus boron combination as well as the transition metal plus boron combination would be classified in class 502, subclass 152. The lanthanide or actinide plus aluminum cocatalyst would be classified in class 502, subclass 102. The transition metal plus aluminum cocatalyst would be classified in class 502, subclass 103.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. A telephone call was made to John Palmer, Esq., on 4/12/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. An amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. Our fax number is 301 5-3599.



Mark L. Bell  
Supervisory Patent Examiner  
Technology Center 1700



J. Pasterczyk

April 23, 1999